

REMARKS/ARGUMENTS

This submission accompanies an RCE and serves as a response to the Office Action dated January 22, 2007, in the above-identified application. A Petition for Extension of Time (one month) and the fee therefor are submitted herewith.

Claims 7, 12, 13 and 17-19 are canceled without prejudice or disclaimer. Therefore, claims 1-6, 8-11, 14-16 and 20 are the claims currently pending in the present application.

Claims 1, 5 and 11 are amended to clarify features recited thereby.

Rejection of Claim 20 under 35 U.S.C. § 112, Second Paragraph

Claim 20 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite on the ground that the term “medical device” lacks antecedent basis. It is respectfully submitted that claim 20 depends from claim 1 which recites “an operating mechanism for a medical device.” Accordingly, the term “medical device” has sufficient antecedent basis.

Rejection of Claims 1, 3-8, 10-14 and 16 under 35 U.S.C. § 102

Claims 1, 3-8, 10-14 and 16 are rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by Lee (2003/0090352). Reconsideration of this rejection is respectfully requested.

Claims 1, 5 and 11 require an operating mechanism comprising a biasing unit configured to bias the moving member from the position in which the switching unit designates the operation to the position in which the switching unit designates no operation. Lee discloses a hermetically sealed electrical switch assembly that provides on-off switching. The Office Action alleges that the frictional resistance inherent in any switch is equivalent to the biasing means for the moving member (Office Action, page 3).

However, Lee does not disclose or suggest a biasing unit that biases the moving member from a position in which an operation is designated to a position in which no operation is designated. First, as discussed in the Amendment filed on November 7, 2006, by equating the frictional resistance inherent in any switch with the biasing means, the Examiner essentially reads out from the claim the biasing unit recited by the claims, since any switch movable between physical positions would encounter some resistance in movement. Further, Lee does not disclose or suggest a biasing unit that biases a moving member from the position designating the operation to the position designating no operation, as required claims 1, 5 and 11. Thus, while a frictional resistance may inherently bias a moving member to remain stationary, a frictional resistance of a

ordinary switch would not bias the moving member from a first position of the switch designating the operation of the device to a position designating no operation.

Further, Lee does not disclose or suggest an operating member that includes “an elastic portion deformable in accordance with a user operation.” There is no deformable switch or operating member disclosed by Lee.

Claims 3 and 4 depend from claim 1, claims 6, 8 and 10 depend from claim 5, and claims 14 and 16 depend from claim 11, therefore, claims 3, 4, 6, 8, 10, 14 and 16 are patentably distinguishable over the cited art for at least the same reasons as their respective base claims.

Rejection of Claims 1-16 under 35 U.S.C. § 103

Claims 1-16 are rejected under 35 U.S.C. § 103 as being obvious from Taira (4,982,726) and Horton (5,701,200), in view of Giannini (4,025,885). Reconsideration of this rejection is respectfully requested.

Claim 1 requires “a moving member disposed inside the air-tight unit...and a switching-function change-over unit adapted to move the moving member by magnetic force into the position in which an operation is designated, the magnetic force moving the moving member in accordance with the operation of the operating member and in opposition to the biasing force of the biasing unit.” Further, claim 5 requires “a moving member disposed inside the air-tight unit...and a switching-function change-over portion operable to control the switch by varying the position of the moving member by exerting a magnetic force on the moving member in opposition to the biasing force of the biasing unit.” Finally, claim 11 requires “a moving member disposed inside the air-tight unit...and a switching-function change-over means for varying the position of the moving member by exerting a magnetic force on the moving member in opposition to the biasing force of the biasing means.”

Taira discloses an endoscope system with a suction channel of a controllable strength of suction (Taira, Abstract), including a switch 9 that includes a spring 9a wound around a rod 9b (Taira, Figs. 2(A) and 2(B); column 2, lines 42-45). Taira discloses that, according to how much the suction switch 9 is pressed down by an operator, a different amount of light can be transmitted through the photo interrupter 10, so that an extent of depression of the suction switch 9 can be determined from an interruption signal outputted from the photo interrupter 10 (Taira, column 2, lines 45-51).

The Examiner asserts that "endoscopes are intended to be inserted into the body and, unless desired to be contaminated with fluids and gases, are designed to be air-tight." However, it is typically body liquids or splashing of cleaning liquids or fluids for blowing off drainage adhered to the observation window of the medical device that may enter or contaminate an endoscope or medical device. Accordingly, a person of ordinary skill in the art may employ a watertight structure to prevent the contamination by body fluids or the splashing of cleaning fluids. Thus, an endoscope or medical device is not required or designed to be air-tight.

Taira does not disclose or suggest a switch with a moving member that actuates a change in operation, wherein the moving member is controlled using magnets from outside of the air-tight unit. For example, according to an aspect of the invention claimed in claims 1, 5 and 11 and shown in Fig. 2 of applicant's disclosure, a first magnet 63 is moved by operation of the operating member 61 causing the moving member 50 to be moved against the urging of the coil 65 because of the magnetic force experienced by the second magnet 64 attached to the moving member 50. Accordingly, an air-tight switch is provided with which the operating member 61 interacts without contact by means of the magnetic force. Taira does not disclose or suggest a switching-function change-over unit (or portion per claim 5, or means per claim 11) that varies the position of or that moves the moving member inside the air-tight unit by magnetic force into the position in which the operation is designated, as required by claims 1, 5 and 11.

Horton does not cure the above-cited deficiencies of Taira as they relate to the above-noted features of claims 1, 5 and 11. Horton discloses a monolithic lens relay system suited for use in an endoscope. Horton does not disclose or suggest a switching-function change-over unit (or portion per claim 5, or means per claim 11) for varying the position of or for moving the moving member inside the air-tight unit by magnetic force into the position in which the operation is designated.

Giannini also does not cure the deficiencies of Taira as they relate to the above-noted features of claims 1, 5 and 11. Giannini discloses a sealed permanent magnet switch in which a control element 12 and a follower element 14 (control and follower element both being magnets) are disposed along an axis with their poles facing one another, and a set of electrical switch contacts coupled to be selectively opened or closed depending on the position of the follower magnet (Giannini, Abstract). Giannini discloses that the control magnet exerts a repulsive force

causing the follower magnet to move axially between the first and second limits of motion (Giannini, column 1, lines 27-32).

The magnet switch of Giannini appears to be a bias unit because the switch moves the follower permanent magnet element 14 against the force of the spring 108 when the magnets have an S to S (South to South) or N to N (North to North) relation. However, when the magnets do not have this S to S or N to N relation, that is, when the magnets are not in a state of repulsion with respect to each other, the spring 108 only serves to return the follower permanent magnet element 14 to its initial position. That is, when the magnets are aligned S to S or N to N, the spring 108 cannot return the follower permanent magnet element 14 to its initial position, even if the control permanent magnet element 12 is released by the hand of the operator.

Accordingly, Giannini does not disclose or suggest that a switch is changed over to the on position only when a predetermined operation is performed but is otherwise in a default off position. That is, Giannini does not disclose or suggest biasing the moving member "from the position in which the switching unit designates the operation to the position in which the switching unit designates no operation," as required by claims 1, 5 and 11.

Further, Giannini discloses that, after the control element 12 is rotated beyond the limit 104a of the follower element 14, a 90° rotation of magnet 51 in a counterclockwise direction is required to bring the two magnets into oppositely poled alignment while a 270° rotation of the follower element 14 in the clockwise direction is required to attain oppositely poled alignment (Giannini, column 8, lines 10-18), and that the rotational limits of control element 12 may be reduced somewhat by placing a compression spring 108 within the hollow center of member 60 to resiliently bias the follower element 14 toward the spaced-apart position (the spaced-apart position being the position in which opposing poles of the control and follower elements do not directly face each other), and thus the axial forces on follower element 14 will become neutralized while the control element 12 is disposed at a rotational position at which attractive forces still remain between the magnets 30 and 51 (Giannini, column 8, lines 33-41). Thus, Giannini discloses aligning the control element 12 and the follower element 14 with respect to one another by means of a compression spring within the hollow center of the member 60 to bias the follower element toward the spaced-apart position so that the control element 12 and the follower element 14 may be properly aligned.

Giannini does not disclose or suggest a switching-function change-over unit (or portion per claim 5, or means per claim 11) that moves the moving member inside the air-tight unit by magnetic force in opposition to the biasing force of the biasing unit (such as the urging force of the coil 65), as required by claims 1, 5 and 11. That is, Giannini does not disclose or suggest a switching-function change-over unit (or portion per claim 5, or means per claim 11) that exerts a magnetic force on a member designating an operation of the switch, such that the magnetic force is in opposition to a biasing force. Accordingly, even taken together in combination, Taira, Horton and Giannini do not disclose or suggest the recitations of claims 1, 5 and 11.

Further, it is respectfully submitted that there is no suggestion or motivation for combining the references taught in the cited references. The Examiner seems to acknowledge that there is no such suggestion or motivation (Office Action, page 6), but alleges that one of ordinary skill in the art would have known about the type of teachings provided in Giannini, and alleges that the motivation would have been implicit and apparent to one of ordinary skill in the art. Giannini does not disclose or suggest a medical or surgical device, let alone an endoscope. It is respectfully submitted that, in making a proper rejection over a combination of references, the suggestion or motivation for combining must be present in the cited art and the Examiner cannot rely on his or her intuition about what a person of ordinary skill in the art would have or would not have known or realized.

Claims 2-4 depend from claim 1, claims 6 and 8-10 depend from claim 5 and claims 14-16 depend from claim 11. Accordingly, claims 2-4, 6, 8-10 and 14-16 are patentably distinguishable over the cited art for at least the same reasons as their respective base claims.

In view of the foregoing discussion, withdrawal of the rejection and allowance of the application are respectfully requested. Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

Respectfully submitted,

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